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APPLICATION NO. FILING DATE		LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
09/514,759	9/514,759 02/28/2000		John Vivian Wood	SWIN 2012	9358	
7812	7590	02/13/2004	EXAMINER			
SMITH-HIL			THALER, MICHAEL H			
12670 N W B SUITE 104	BARNES	ROAD	ART UNIT	PAPER NUMBER		
PORTLAND	, OR 97	229	3731	15		
				DATE MAILED: 02/13/2004	;	

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

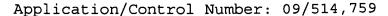
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•		Арр	licati n No.	Applicant(s)	(\mathcal{N})				
Office Action Summary			514,759	WOOD ET AL.	$C_{\mathcal{M}}$				
			miner	Art Unit	1				
			nael Thaler	3731					
The M Period for Reply	NAILING DATE of this commu	nication appears (on the cover sheet	with the correspondence a	ddress				
THE MAILING - Extensions of tin after SIX (6) MC - If the period for - If NO period for - Failure to reply Any reply receiv	IED STATUTORY PERIOD G DATE OF THIS COMMUN me may be available under the provision DNTHS from the mailing date of this com reply specified above is less than thirty reply is specified above, the maximum within the set or extended period for rep yed by the Office later than three months erm adjustment. See 37 CFR 1.704(b).	NICATION. ns of 37 CFR 1.136(a). In nmunication. (30) days, a reply within statutory period will apply ly will, by statute, cause	n no event, however, may the statutory minimum of y and will expire SIX (6) N the application to become	r a reply be timely filed thirty (30) days will be considered tim IONTHS from the mailing date of this ABANDONED (35 U.S.C. § 133).	ely. communication.				
Status									
1)⊠ Respo	nsive to communication(s) fi	led on <u>13 Januar</u>	<u>y 2004</u> .						
2a)⊠ This ad	This action is FINAL . 2b) This action is non-final.								
3)☐ Since t	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is								
closed	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.								
Disposition of C	laims								
4a) Of t 5) ☐ Claim(6) ☑ Claim(7) ☐ Claim(✓ Claim(s) 15-52 is/are pending in the application. 4a) Of the above claim(s) 48-52 is/are withdrawn from consideration. ☐ Claim(s) is/are allowed. ☑ Claim(s) 15-47 is/are rejected. ☐ Claim(s) is/are objected to. ☐ Claim(s) are subject to restriction and/or election requirement. 								
Application Pap	ers								
9)∐ The spe	ecification is objected to by t	the Examiner.							
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.									
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).									
•	ement drawing sheet(s) including the or declaration is objected	_							
Priority under 3	5 U.S.C. § 119								
a)	vledgment is made of a clair b) Some * c) None of: Certified copies of the priorit Certified copies of the priorit Copies of the certified copies application from the Internat attached detailed Office act	ty documents hav ty documents hav s of the priority do ional Bureau (PC	re been received. re been received ir ocuments have be T Rule 17.2(a)).	n Application No en received in this Nationa	al Stage				
Attachment(s)									
1) Notice of Refe	erences Cited (PTO-892)			w Summary (PTO-413)					
3) Information Di	tsperson's Patent Drawing Review isclosure Statement(s) (PTO-1449 fail Date			No(s)/Mail Date of Informal Patent Application (P 	TO-152)				
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Claims 48-52 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

Claims 15-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. (5,242,458). Bendel et al. show a biocompatible gripping device for surgical use including at least one deformable gripping element (at I) comprising shape memory material (col. 3, lines 55-63). The amount of functional porosity of the material is not disclosed in the reference. However, it would have been obvious that there exists at least a very small amount of functional porosity in the Bendel et al. material since materials in general are porous to some degree (even if it is a very small degree) and the amount of functional porosity is not claimed. The deformable gripping element (at I) in fact, be returned to its non-deformed condition on heating after releasing the article, as broadly claimed. During its intended use, the gripping element I returns to its nondeformed condition after releasing the article as indicated in col. 3, lines 61-63. However, the gripping element, when used in a cold environment (below the martensite to austenite phase transition temperature) would inherently remain in its deformed condition after releasing the article since it would be in the martensite phase. Further, it would inherently return to its



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non-deformed condition upon heating (to room temperature for example) since heating it would change its state from the martensite to austenite. Since the rejected claims are apparatus claims rather than method of use claims and since the Bendel et al. device is inherently capable of being used as claimed, the rejection is proper.

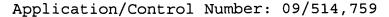
Claims 15-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. (5,242,458) in view of Davis (4,839,479). Assuming arguendo that the material of the Bendel et al. inserts I has absolutely no functional porosity, it would have been obvious to provide such porosity to the material in order to enhance the speed of recovery of the insert after deformation in view of the Davis teaching of making shape memory materials porous for this reason (col. 6, lines 40-63).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's arguments filed Jan. 13, 2004 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this



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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

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mht 2/6/04 MICHAEL THALER
PRIMARY EXAMINER
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